

REMARKS

The Office Action of September 8, 2005 presents the examination of claims 14-33. The present paper amends claims 14, 15 and 24-27, and cancels claim 16.

Interview

An interview with the Examiner and his supervisor was conducted on November 21, 2005. This paper reflects the substance of that interview.

Rejection under 35 U.S.C. § 112, second paragraph

Claim 22 is rejected under 35 U.S.C. § 112, second paragraph, for alleged indefiniteness. This rejection is respectfully traversed. Reconsideration and withdrawal thereof are requested.

In particular, the Examiner asserts that the claim 22 recites, “the template” and this is indefinite because claim 17 from which claim 22 depends recites two different templates. As explained in the interview, claim 22 expressly states that the template of reaction i) is what is referred to. The Examiner accepted this explanation and Applicants’ Representative believes that this rejection will now be withdrawn.

Rejection over Lanar

Claims 14-19, 21, 23-25 and 32-33 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Lanar et al. WO ‘949. This rejection is respectfully traversed. Reconsideration and withdrawal thereof are requested.

As explained in the interview, there are at least two distinctions between the present invention and that disclosed by Lanar. The first, now incorporated into claims 14 and 15, was originally presented in claim 16, now canceled. That is, the present invention as described in claims 14 and 15, and claims dependent thereon, includes an amplification reaction that utilizes

two primers that are not gene specific and have the same sequence. This feature is not at all disclosed or suggested by Lanar.

Claim 17 recites the second distinction between the present invention and the disclosure of Lanar. That is, the downstream primer used in the first amplification step is not gene specific in the instant invention. As explained in the interview, this is reflected in the language of claim 17 in that the primer is said to “anneal with a portion of the vector sequence downstream from the protein-coding region.” On the other hand, both of the primers used by Lanar in the first amplification reaction are gene-specific. See, e.g. page 12, lines 19-20 of the reference, “The sequence of the reverse primer was specific to a downstream segment of the same gene but on the complementary strand.”

Thus, claims 14-19, 21, 23-25 and 32-33 are distinct from what is disclosed by Lanar WO ‘949 and the instant rejection should be withdrawn.

In the interview, the Examiner indicated that the above explanation was persuasive, but reserved comment on allowability until final claim language was presented.

Rejection over Lanar in view of Rothschild

Claims 14-28, 30 and 32-33 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Lanar WO ‘949 in view of Rothschild ‘337. This rejection is respectfully traversed. Reconsideration and withdrawal thereof are requested.

Applicants submit that the Examiner fails to establish *prima facie* obviousness of the presently claimed invention. The distinctions between the present invention and Lanar WO ‘949 are explained above. Rothschild ‘337 is cited only for its disclosure of “His-tagging” of proteins. Rothschild ‘337 does not remedy the failure of Lanar WO ‘949 to disclose or suggest the features of the primers used in the present invention as explained above. Thus, the combination of Lanar WO ‘949 with Rothschild ‘337 does not disclose or suggest every element of the present invention and so the instant rejection fails and should be withdrawn.

Rejection over Lanar, Rothschild and Tchaga

Claims 14-33 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Lanar WO '949 in view of Rothschild '337, as applied above, in further view of Tschaga et al. WO '992. This rejection is respectfully traversed. Reconsideration and withdrawal thereof are requested.

Applicants submit that the Examiner fails to establish *prima facie* obviousness of the claimed invention. The teachings of Lanar WO '949 and Rothschild '337 and the distinction of the present invention over their combination is explained above. Tchaga is further cited for disclosure that the His tag that should be employed is a "native" His tag. Tchaga WO '992 does not remedy the deficiencies of Lanar WO '949 and Rothschild '337 to disclose or suggest the features of the primers used in the present invention as explained above. Thus, the combination of Lanar WO '949 with Rothschild '337 and Tchaga WO '992 does not disclose or suggest every element of the present invention and so the instant rejection fails and should be withdrawn.

The present application well-describes and claims patentable subject matter. The favorable action of allowance of the pending claims and passage of the application to issue is respectfully requested.

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Amendment dated December 8, 2005
After Final Office Action of September 8, 2005

Docket No.: 1686-0108P

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Mark J. Nuell (Reg. No. 36,623) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

Dated: December 8, 2005

Respectfully submitted,

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